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| Application Number | 09/134,771 |
| Filing Date | August 12, 1998 |
| First Named Inventor | SAH et al |
| Examiner Name | S. Kaushal |
| Group Art Unit | 1636 |

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Attorney Docket No. 010624-0009-999

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| <input type="checkbox"/> Certified Copy of Priority Document(s) | | |
| <input type="checkbox"/> Response to Missing Parts/ Incomplete Application | | |
| | | (X) Petition for Extension of Time (one month) (in duplicate); (X) Response to Communication Concerning Applicant's Appeal Brief; (X) Submission of Brief on Appeal (X) Brief on Appeal in triplicate (with attached Exhibits 1 through 7) |
| | Remarks: | |

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

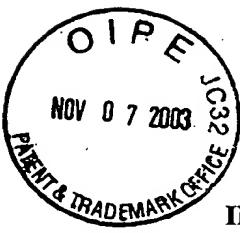
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| Firm Or Individual Name | Pennie & Edmonds LLP Lawrence S. Graham, Reg. No. 49,020 |
| Signature | |
| Date | November 7, 2003 |

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: SAH et al Confirmation No.: 8421
Serial No.: 09/134,771 Art Unit: 1636
Filed: August 12, 1998 Examiner: S. Kaushal
For: Human Mesencephalon Cell Attorney Docket No: 10624-009-999
Lines and Methods of Use
Therefor

RESPONSE TO COMMUNICATION
CONCERNING APPLICANTS' APPEAL BRIEF

Mail Stop Appeal Brief - Patents
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Sir:

In response to the September 30, 2003 Communication ("Communication") from the Examiner regarding the Appeal Brief filed July 21, 2003, and further to the teleconference with the Examiner, Applicants respond to the Communication as follows. Applicants submit herewith (1) an amended Appeal Brief in triplicate, and (2) a Petition for Extension of Time of one (1) months, with provision for the appropriate extension fee.

Interview Summary

Applicants thank the Examiner for the courtesy of the telephonic interview held between the Examiner and Applicants' representatives, Mr. Anthony M. Insogna and Mr. Lawrence S. Graham on October 10, 2003. In the Interview, the participants discussed the two aspects in which the Examiner believed the Appeal Brief is defective, as explained in the Communication. Applicants' representatives indicated that they would re-submit the Appeal brief with a Description of the Invention that conforms to 37 C.F.R. 1.192(c)(5). Applicants also pointed out that their Appeal Brief does not raise any new issue but merely addresses the 35 U.S.C. § 103 rejection. In addition, Applicants pointed out that they have not made a new argument (notwithstanding that there is no prohibition against "new" arguments in an Appeal Brief). Lastly, Applicants indicated that they would point out to the Examiner arguments

made during prosecution to demonstrate previous traversal of the Examiner's assertion of equivalency of human and mouse mesencephalon progenitor cell types.

Response to Communication

In the Communication, the Examiner indicated that the Appeal Brief is defective because it "does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refers to the specification by page and line number" as required by 37 C.F.R. 1.192(c)(5). Applicants have amended the Summary of the Invention to incorporate claim language and to refer to the specification by page and line number.

The Examiner also indicated in the Communication that:

[t]he brief is further defective because it raises new issues that were not presented before. The brief as filed requires that "The Examiner is called upon to file a Declaration to support the contention that rat neuronal stem or progenitor cells are equivalent to human neural stem or progenitor cells. Absent this, the rejection is improper." . . . This is a newly raised issue not presented before. Applicant[s] also did not previously traverse the equivalency of the cell types.

The non-equivalency of human and rat neural progenitor cells is not a new issue, nor is Applicants' position a new argument. Rather, this has been the focus of the prosecution for the last several years. The Examiner, in rejections of the claims under 35 U.S.C. § 103, has consistently combined art disclosing rat cells (*e.g.*, Hoshimaru *et al.*) with art disclosing human cells (*e.g.*, Boss *et al.*). Applicants have already argued against the combination of references on the basis of the non-equivalency of rat and human neural progenitor cells. *See, e.g.*, Paper No. 31, Amendment under 37 C.F.R. 1.116, page 4, Section I.B.2 and page 6, second paragraph; Paper No. 25, Amendment under 37 C.F.R. 1.111, page 5, third paragraph. Indeed, in Paper No. 32, Advisory Action, mailed April 14, 2003, the Examiner states "[t]he Applicant concluded that rat cells are [a] composition of matter that is different from human cells, therefore [the] invention as claimed is not obvious over the cited prior art of record."

In any case, even if, *arguendo*, Applicants' argument regarding the non-equivalency of the cell types were new, there is no prohibition in the rules preventing Applicants from making such an argument in the Appeal Brief.

The Examiner explicitly stated that "mammalian mesencephalon neuron progenitor cells (mouse and human) are considered to have identical characteristics . . ." for the first time in the Advisory Action (Paper No. 32) mailed April 14, 2003. It was this statement that

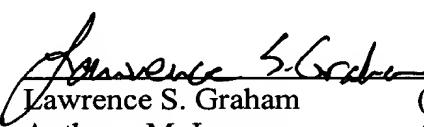
prompted Applicants to call for a supporting Declaration by the Examiner. As mentioned above, there is no prohibition against such a request. It raises no new rejections or issues other than the sufficiency of the Examiner's rejection. If the Examiner concedes that a Declaration is necessary to sustain the rejection, the proper action is allowance of the application or submission of such a Declaration.

Applicants believe that the Appeal Brief, as amended, is now in condition for entry.

Respectfully submitted,

Attorney for Appellants

Date: November 7, 2003


For: Lawrence S. Graham (Reg. No. 49,020)
Anthony M. Insogna (Reg. No. 35,203)

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Attachments